## REMARKS

This Application has been carefully reviewed in light of the final Office Action dated January 20, 2011 ("*Office Action*"). At the time of the *Office Action*, Claims 1-5, 7-22, 24-28, and 30-38 were pending and rejected. Applicants have amended Claims 1, 8, 14, 25, and 33-38. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

### Section 112 Rejection

The Examiner rejects Claims 1-5, 7-22, 24-28, and 30-35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, and with regard to independent Claims 1, 14, and 28, the Examiner states that "[t]here are two different 'machine readable code' on the return shipping label as recited in the previous steps. Thus, it is not clear which one will be scanned by the merchant or by the specialized return center as indicated in the last step." Applicants respectfully disagree and submit that the claims are clear under 35 U.S.C. § 112, second paragraph. However, to advance this case, Applicants have amended independent Claims 1, 14, and 28 and appropriate dependent claims to distinguish "the first machine readable code" from the "second carrier-specified machine readable code."

For at least these reasons, Applicants respectfully request that the rejection of Claims 1-5, 7-22, 24-28, and 30-35 under 35 U.S.C. § 112, second paragraph be withdrawn.

### Section 103 Rejections

The *Office Action* states that Claims 1-5, 7-22, 24-28, and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0013744 issued to Tsunenari et al. ("*Tsunenari*") in view of U.S. Patent No. 6,015,167 issued to Savino et al ("*Savino*") and further in view of Official Notice. Applicants traverse these rejections for the following reasons.

Independent Claim 1 of the present Application, as amended, recites:

A computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the steps of:

accessing item data representing at least one detail about the item;

accessing transaction data representing at least one detail about the transaction associated with the item including an identification of the transaction;

accessing customer data representing at least one detail about a customer associated with the transaction including a shipping origin;

accessing package data representing at least one detail about the package in which the item is expected to be shipped;

using a computer operated by the merchant from whom the item was acquired or a specialized returns center associated with the merchant to process returns to correlate the item data, transaction data, customer data, and package data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center;

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to generate a first machine readable code for the return shipping label for shipment from the customer to the returns center, wherein the data represented by the first machine readable code comprises a plurality of data points, at least a first of the plurality of data points included in the first machine readable code representing at least the shipping origin of the package and at least a second data point in the first machine readable code representing the identification of the transaction;

in response to correlating the item data, transaction data, customer data, and package data with the set of stored business rules specifying how packages are to be shipped from the customer to the returns center, using the computer operated by the merchant from whom the item was acquired or the specialized returns center associated with the merchant to format the return shipping label, such that the return shipping label contains the first machine readable code and complies with shipping label specifications of the choice of carrier, the first machine readable code not associated with the carrier and in addition to a second carrier-specified machine readable code also present on the shipping label; and

in response to receiving the package containing the item for return, scanning the first machine readable code by the merchant or by the specialized returns center to correlate the first machine readable code with

one or more business rules for performing returns processing for the merchant associated with the transaction.

Thus, Applicants' claim relates to the generation of a return shipping label that "complies with the shipping label specifications of the choice the carrier" and includes both "a first machine readable code" and a "second carrier-specified machine readable code." Applicants' claims further requires that the first machine readable code is "not associated with the carrier" but that the shipping label still "complies with shipping label specifications of the choice of carrier." Whether considered alone or in combination, *Tsunenari* and *Savino* do not disclose, either expressly or inherently, each and every element of the claims.

In the *Office Action*, the Examiner relies upon *Tsunenari* for disclosure of "the return shipping label" having a "carrier-specified machine readable code" but acknowledges that *Tsunenari* "does not <u>explicitly</u> <u>disclose</u> the shipping label contains an additional machine readable code that represents at least the shipping origin of the package and the identification of the transaction." (*Office Action*, pages 6 and 14-15). The Examiner points to *Savino* for disclosure of the "machine readable code" that is not associated with the carrier. (*Office Action*, pages 6-7 and 15). Applicants respectfully disagree.

While *Tsunenari* discloses a typical carrier shipping label (*Tsunenari*, paragraphs 62 and 81), Applicants continue to submit that *Savino* does not relate to a shipping label that is included on the outside of a package at all. Rather, though *Savino* uses the term "shipping label," the "shipping label" is more likely a "packing slip" or something analogous to a packing slip. (*Savino*, Column 1, lines 36-50: Figures 3 and 5).

Specifically, *Savino* describes that the label includes "a single bar code" that is "linked with purchase and shipping information associated with a purchase order." (*Savino*, Column 2, lines 7-10). With regard to the "shipping label," *Savino* states:

> FIG. 3 illustrates a shipping label 100 generated by the system 10 in accordance with the present invention. The shipping label includes a single-block bar code 102 which when scanned accesses the scanning system to a plurality of predetermined relevant purchase and shipping information associated with a purchase order which is stored in the supplier database 14 or digital processor 12. A "trigger number" 104 provides an alternative means for accessing the purchase and shipping information provided by the bar code 102. The shipping label 100 may also list some of the purchase and shipping information such as, for

example, a customer purchase order number 106, a box quantity number 108, a part quantity number 110 and a customer part number 112.

(*Savino*, column 3, lines 48-61). Thus, though the label is termed a "shipping label" it is not a carrier label and has none of the usual features of a shipping label. Rather, the "shipping label" of merely includes the bar code identifying a packing slip number and printed matter that relates to the customer purchase order no., the number of boxes, the quantity, and the customer part number (*Savino*, Figure 3). Accordingly, neither *Tsunenari* nor *Savino* disclose a return shipping label that "complies with shipping label specifications of the choice of carrier" and includes both "the first machine readable code not associated with the carrier" and "a second carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

In the *Office Action*, the Examiner answers that "the instant claim language failed to provide specific structure and functional distinction between the claimed "shipping label" and that of *Tsunenari/Savino*." (*Office Action*, page 17). Applicants respectfully disagree. Applicants' Claim 1 recites "using the computer . . . to generate a machine readable code **for the return shipping label for shipment from the customer to the returns center**." As such, Applicants claims do recite specific structure and functional distinction between the claimed "shipping label" and the labels disclosed in *Tsunenari* and *Savino*.

Furthermore, Applicants respectfully submit that the proposed *Tsunenari-Savino* combination is improper. In the *Office Action*, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label of *Tsunenari* to include the shipping label contains the machine readable code which represents customer address and identification of the transaction as taught by *Savino et al* for coordinating shipping and receiving information between supplier/merchant and customers in order to reduce the time consuming and costly." (*Office Action*, page 6-8). It remains Applicants' position, however, that *Savino* teaches away from the proposed combination.

*Savino* specifically relates to a "**single** bar code shipping label." (*Savino*, Column 2, lines 7-10, emphasis added). Throughout, *Savino* praises a label that includes a **single** bar code. According to *Savino*, "if for example, nine bar codes are provided with each packing slip, it will typically take about one minute to scan-in each nine-block label." (*Savino*, Column 1, lines 43-45). As another example, *Savino* explains that "several bar codes

increases the likelihood that one or more of the bar codes provides incorrect information." (*Savino*, Column 1, lines 48-50). With regard to previous packing slips, *Savino* discloses that a "drawback is that the packing slip supplied with each purchase order typically includes several bar codes that are scanned by the customer if equipped with an automated receiving system." (*Savino*, Column 1, lines 36-38). Thus, *Savino* actually teaches away from a shipping label that includes more than one bar code. As a result, *Savino* teaches away from modifying the carrier-specific bar code of *Tsunenari* to include an additional merchant-specific bar code. Even if the proposed combination can be properly made (which Applicants respectfully dispute), the proposed combination merely results in a package having a first shipping label with a carrier-specific bar code (such as that disclosed in *Tsunenari*) and a second packing slip type label with an additional machine readable code (such as that disclosed in *Savino*). The proposed combination does not disclose "the return shipping label contains the first machine readable code and complies with shipping label specifications of the choice of carrier, the first machine readable code not associated with the carrier and in addition to a second carrier-specified machine readable code also present on the shipping label," as recited in Claim 1.

Applicants also further submit that the Examiner's "it would have been obvious" statement does not explain how one of ordinary skill in the art at the time of invention would be motivated to incorporate both the carrier-specific bar code of *Tsunenari* and the merchant-specific bar code of *Savino* in a single carrier shipping label . Rather, the Examiner has merely stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label of *Tsunenari* to include the shipping label contains the machine readable code which represents customer address and identification of the transaction as taught by *Savino et al* for coordinating shipping and receiving information between supplier/merchant and customers in order to reduce the time consuming and costly." (*Office* Action, page 6-8)). The alleged advantages of the system disclosed in *Savino*, however, do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (***without using Applicants' claims as a guide***) to modify the carrier label of *Tsunenari* to include the machine readable code of *Savino* while maintaining compliance with carrier specifications; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1.

Stated differently, the combination of references do not explain how a merchant would create such a label that includes both a machine readable code not associated with the carrier and a carrier-specified machine readable code. If it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

As still another example of the deficiencies of the *Office Action*, Applicants note the Examiner's acknowledgement that neither references discloses "at least a first of the plurality of data points included in the machine readable code representing at least the **shipping origi**n of the package," as recited in Claim 1. (*Office Action*, page 7). Instead the Examiner states that "Official notice is taken that shipping origin information is well known to be included in the shipping label." (*Office action*, page 7). Applicants respectfully traverse this finding.

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. (M.P.E.P., §2144.03). Specifically, official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). (M.P.E.P., §2144.03). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 1, together with Claims 2-13 and 33-35 that depend on Claim 1. For analogous reasons, Applicants request reconsideration and allowance of independent Claims 14 and 28, together with Claims 15-27 and 29-32 that depend on Claims 14 and 28, respectively.

**No Waiver**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Office Action. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Office Action, Applicants do not concede as to the correctness of additional statements made by the Office Action. The example distinctions discussed by Applicants are sufficient to overcome the rejections of the Office Action.
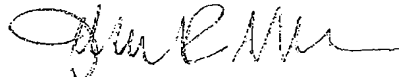
## CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 415-4820.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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